

REMARKS

The applicant respectfully requests reconsideration in view of the amendment and the following remarks. Support for newly added claim 9 can be found in the original claim 4. Support for newly amended claim 1 can be found in the specification at page 6, third paragraph of the description.

Claims 1-8 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a process for preparing lactone using starting material propylene oxide, it does not reasonably provide enablement for a process for preparing lactone using starting material oxiranes without limitation. Claims 1-8 are rejected under 35 U.S.C. §§102(a) and 103(a) as being anticipated and obvious over Allmendinger et al. publication, *Z. Anorg. Allg. Chem.*, 2003 629:1347-1352. Claim 4 is objected to as containing non-elected subject matter, i.e., the claimed catalyst. The applicant respectfully traverses these rejections.

35 U.S.C. §112, First Paragraph Rejection

Claims 1-8 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a process for preparing lactone using starting material propylene oxide, it does not reasonably provide enablement for a process for preparing lactone using starting material oxiranes without limitation. In claim 1, the applicant has amended the oxirane to be ethylene oxide, propylene oxide, butylene oxide, cyclopentene oxide or cyclohexene oxide". Amended claim 1 corresponds to the election of group I. The applicant believes that the claim is clear for a person having ordinary skill in the art and enables him or her to conduct the process according to the amended claim 1. For the above reasons, this rejection should be withdrawn.

35 U.S.C. §103 Rejection

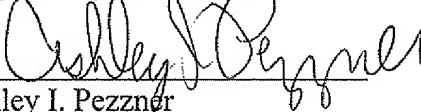
Claims 1-8 are rejected under 35 U.S.C. §§102(a) and 103(a) as being anticipated or in the alternative, being and obvious over Allmendinger et al. publication, *Z. Anorg. Allg. Chem.*, 2003 629:1347-1352.

The present application claims priority of German application DE 102 35 317.4, dated August 1, 2002. The publication that has been cited by the Examiner has been received with WILEY-VCH Verlag GmbH & Co. KGaA, Weinheim, on March 3, 2003. Because the present

application should claim the above-mentioned priority, Allmendinger et al. is not prior art for the present application. The applicant is in the process of procuring a certified translation of their priority document. Once the undersigned receives the translation, the undersigned will file it with the USPTO. This rejection then should be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00132-US from which the undersigned is authorized to draw.

Respectfully submitted,

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